

## **REMARKS**

Claims 15-28 have been amended. Claims 1-42 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Request to withdraw the finality of the current Office Action:**

In the instant Office Action, the Examiner withdrew a previous rejection of claims 1-12, 15-26 and 31-39 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, and newly rejected claims 15-26 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. Specifically, in the instant Office Action, the Examiner asserts that in view of the specification, the recited “computer-accessible medium” may encompass transmission media, and suggests that these claims be amended to recite a storage medium.

Applicants note that the previous rejection under 35 U.S.C. § 101 made no mention of the issue of transmission media. Further, Applicants note that the current rejection of claims 15-26 could have been made in the previous Office Action, and so was not necessitated by Applicants’ amendment to the claims. Applicants therefore submit that the current rejection under 35 U.S.C. § 101 is a new ground of rejection not necessitated by Applicants’ amendment. **Correspondingly, Applicants submit that in view of this new ground of rejection, the finality of the instant Office Action is improper and must be withdrawn.**

As suggested by the Examiner, Applicants have amended claims 15-28 to recite “a computer-accessible storage medium,” and submit that this amendment overcomes the 35 U.S.C. § 101 rejection. Applicants respectfully request that the Examiner withdraw the finality of the Office Action and enter this amendment.

### **Double Patenting Rejection:**

The Examiner rejected claims 13, 14, 27, 28, 41 and 42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 17, 27, 36, 46 and 55 of U.S. Application number 10/670,849, and claims 12 and 26 over claims 8 and 18 of U.S. Application number 10/670,549. Applicant notes that this rejection is necessarily provisional, since the corresponding claims in the copending applications have not yet been patented. Applicant will address this rejection when and if it should become nonprovisional.

### **Section 101 Rejection:**

The Examiner rejected claims 15-26 under 35 U.S.C. § 101 as being drawn towards non-statutory subject matter, in that the specification indicates that a “computer-accessible medium” may encompass a transmission medium. As indicated above, claims 15-28 have been amended to specifically recite a “computer-accessible storage medium,” thus excluding transmission media from the scope of claims 15-28. Applicant submits that the 35 U.S.C. § 101 rejection has been overcome and respectfully requests that it be withdrawn.

### **Section 102(b) Rejections:**

The Examiner rejected claims 1, 3, 6, 7, 10, 15, 17, 20, 21, 24, 29, 31, 34, 35 and 38 under 35 U.S.C. § 102(b) as being anticipated by Aravamudan et al. (U.S. Patent 6,301,609) (hereinafter Aravamudan), and claims 1, 2, 4, 6-8, 12-15, 18, 20-23, 27-29, 32, 34-36 and 37 as being anticipated by Horvitz et al. (PCT Application WO 01/69387) (hereinafter Horvitz). Applicant traverses these rejections and submits that the pending claims are not anticipated by either Aravamudan or Horvitz for at least the following reasons.

Regarding claim 1, neither Aravamudan nor Horvitz teach or suggest, either

separately or in combination, a method comprising detecting a computer system activity level indicative of computer system activity; determining whether said activity level exceeds an activity threshold in response to said detecting; and transitioning a presence state specific to an instant messenger client to a busy state in response to determining that said activity level exceeds said activity threshold, wherein said presence state corresponds to a given user.

**1. Aravamudan fails to anticipate the independent claims.**

In rejecting claim 1 in view of Aravamudan, the Examiner refers broadly to columns 7-8 of Aravamudan, asserting that these teach “activity detection in an instant messaging system with ‘active state’ which means ‘busy’ state, and activity thresholds” and that “Aravamudan’s activity threshold requires activity to occur in a certain amount of time in order to change to an active or busy state.” Applicant traverses the Examiner’s assertions for at least the following reasons.

**A. Aravamudan fails to disclose either a presence state specific to an instant messenger client or an activity threshold.**

Aravamudan discusses a “method utilized to communicate to the Communication Services Platform (CSP) a user’s inactivity while utilizing a client premises equipment (CPE) device registered as online.” (emphasis added) In this passage, Aravamudan describes a CPE device “monitor[ing] for user interaction with a user interface.” If such interaction is sensed, “and the previous state was inactive, then the CPE devices generates an active message and conveys [it] to the CSP.” If no interaction is sensed over a period of time T that exceeds a limit, “the CPE device generates an inactivity message and conveys [it] to the CSP.” Aravamudan, col. 7, line 41 – col. 8, line 4.

Numerous differences exist between the disclosure of Aravamudan and the requirements of claim 1. First, and most generally, Aravamudan does not disclose any aspect of transitioning a presence state that is specific to an instant messenger client.

Aravamudan describes that a CPE device monitors for general user activity, and if such activity is detected, the CPE device generates and conveys an active message to the CSP via an IM server. Aravamudan makes no mention whatsoever of instant messenger presence states that are specific to an instant messenger client. To the extent Aravamudan describes “state” at all, it is in broadly referring to the state of the entire CPE device, e.g., as active or inactive, based on the monitored user interaction with the device. In fact, Aravamudan does not disclose any level of integration or connection between CPE device state and presence state that is specific to an IM client, much less the transitioning of presence state recited in claim 1. Rather, in Aravamudan, detected user interaction and the corresponding active message are specific to the CPE device as a whole, not to an IM client that might be executing on that device.

Further, Aravamudan fails to disclose determining whether a computer system activity level exceeds an **activity threshold** in response to detecting computer system activity. Contrary to the Examiner’s assertion, the threshold described by Aravamudan is not an activity threshold but a time threshold. That is, Aravamudan compares “the time from last activity (T) . . . to a specified inactivity time limit (LIMIT).” *Id.* A time threshold is simply incommensurate with, and not suggestive of, an activity threshold. Elapsed time and computer system activity are different phenomena measured using different units.

**B. Aravamudan is directed to detecting inactivity, not activity.**

Aravamudan also fails to disclose determining whether a computer system activity level exceeds an activity threshold in response to detecting computer system activity. Apart from the fact just noted that Aravamudan’s time threshold is not an activity threshold, Aravamudan clearly discloses that the time threshold is not evaluated in response to detecting computer activity, but rather “if **no interaction** with a user interface is sensed.” Aravamudan at col. 7, lines 59-61, emphasis added. That is, Aravamudan does not determine the status of a threshold in response to detecting activity, but rather in response to detecting inactivity. This is in fact the opposite of Applicant’s

claim 1.

Similarly, in addition to the fact demonstrated above that Aravamudan does not disclose any aspect of transitioning a presence state specific to an IM client, Aravamudan fails to disclose transitioning such a presence state to a busy state in response to determining that said activity level exceeds said activity threshold. Instead, Aravamudan discloses that if the elapsed time since the last detected activity exceeds the inactivity time limit, “the CPE device generates an inactivity message and conveys [it] to the CSP via the IM server.” Aravamudan at col. 8, lines 1-2, emphasis added. That is, rather than transition a presence state to a busy state in response to determining that an activity level exceeds an activity threshold, Aravamudan discloses generating an inactivity message in response to determining that there has been no activity for a threshold period of time. Generating an inactivity message under these conditions is precisely the opposite of the transition to a busy state that is required by claim 1.

For at least the foregoing reasons, Applicant submits that Aravamudan fails to anticipate claim 1 or similar independent claims 15 and 29.

## **2. Horvitz fails to anticipate the independent claims.**

In rejecting claim 1 in view of Horvitz, the Examiner refers to pp. 14 and 21-23 of Horvitz, which discuss “predetermined thresholds” and “attentional focus” with respect to whether a user should receive notification alerts. Applicant traverses the Examiner’s assertions that Horvitz anticipates any of independent claims 1, 15, or 29 for at least the following reasons.

### **A. Horvitz fails to disclose any aspect of a presence state specific to an instant messenger client.**

Horvitz is broadly directed to a system and method “to enable a variety of information associated with . . . notification sources to be directed to . . . notification

sinks . . . via a notification platform architecture.” Horvitz, Abstract. Horvitz further discloses that decisions regarding whether and where to direct such notifications may involve “a user’s state such as location and attentional focus.” *Id.* Horvitz suggests that an instant message may serve as a “notification source” within the overall notification platform architecture. Horvitz at 16. However, Horvitz does not disclose any details whatsoever regarding the behavior or implementation of an instant messenger client, and more specifically fails to disclose the transitioning of a presence state specific to such a client as required by claim 1. In Horvitz, instant messaging is merely one source of notification information among many, and the disclosures of Horvitz are not concerned with the details of the relationship between user activity information and instant messenger presence state.

More particularly, contrary to the Examiner’s assertion, Horvitz’s “attentional focus” and “attentional state” have nothing whatsoever to do with a presence state specific to an instant messenger client. Horvitz tends to use the terms “attentional focus,” “attentional status,” and “attentional state” interchangeably to broadly refer to whatever a user happens to be paying attention to at a given time. For example, at the passage cited by the Examiner, Horvitz states, “However, if the user is currently talking on the cell phone 114, this can indicate that the user has his or her attentional focus on something else (namely, the current phone call), such that the user should not presently be disturbed with a notification alert.” Horvitz at 21. Horvitz’s broad use of “attentional focus” to connote a user’s subjective state of mind is devoid of any suggestion of a presence state specific to an instant messenger client. Simply because such a presence state may also be used to convey information regarding a user’s state does not entail that the two entities are identical or that Horvitz’s “attentional focus” inherently and necessarily discloses a presence state specific to an IM client.

**B. Horvitz fails to disclose detecting or acting in response to computer system activity that exceeds an activity threshold.**

The Examiner suggests that Horvitz’s “predetermined thresholds” disclose the

activity threshold recited in claim 1. However, beyond sharing use of the term “threshold,” Horvitz’s disclosure has nothing to do with determining whether a detected computer system activity level exceeds an activity threshold, and taking a particular action (e.g., transitioning a presence state specific to an instant messenger client) in response to determining that the detected activity does exceed the activity threshold.

Horvitz’s discussion of thresholds has to do with the relative importance of a notification received from a notification source. For example, Horvitz describes determining “whether the user is only available to receive alerts that has an importance level greater than a predetermined threshold. . . . As depicted in FIG. 5, a threshold can be measured in dollars.” Horvitz at 20. Horvitz subsequently describes the importance level determination in more detail:

The net value of conveying notifications to the user via the modes of the sinks can be determined at 184 by subtracting from the expected value of information determined in 186, the expected cost of disruption determined in 188, the expected value of the user independently learning the information in 190, and the actual cost of communication in 192. At 194, it is determined whether the net value for substantially any mode of substantially any sink is greater than a predetermined conveyance threshold. For example, where the net value is measured in dollars (\$), the predetermined conveyance threshold may be zero.

Horvitz at 28. Here, Horvitz is clearly speaking in terms of factors such as “cost of disruption,” “cost of communication,” and “expected value” of notification. Horvitz describes these features in greater detail in the context of a decision-theoretic predictive model that attempts to quantify the abstract value of notification relative to the costs of interrupting the user in his or her current context. However, this simply does not meet the plain language of Applicant’s claims. Horvitz’s abstract “conveyance threshold” is incommensurate with a recitation of an activity threshold that is compared against a detected computer system activity level.

In response to Applicant’s previous arguments, the Examiner makes the broad assertion that “[b]oth Aravamudan and [Horvitz] have an instant messenger client. The amended claim language is not patentable over the prior art since the references have

instant messaging.” Applicant traverses the Examiner’s assertion and note that the pending claims are not directed merely to having “instant messaging,” but to particularly recited features interrelated in specifically recited ways. A mere assertion of “instant messaging,” to the extent the cited references even disclose this feature, does not amount to a disclosure of the specific features of independent claims 1, 15, and 29.

Applicant notes that anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. M.P.E.P. 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Both Aravamudan and Horvitz fail to meet this standard with respect to claims 1, 15, and 29. Therefore, Applicants submit that these references cannot be said to anticipate the independent claims.

### **Section 103(a) Rejections:**

The Examiner rejected claims 4, 8, 9, 11, 18, 22, 23, 25, 32, 36, 37 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Aravamudan in view of Horvitz (U.S. Patent 6,622,160) (hereinafter “Horvitz ‘160”), claims 5, 19 and 33 as being unpatentable over Aravamudan in view of Desimone et al. (U.S. Patent 6,212,548) (hereinafter “Desimone”), claims 16 and 30 as being unpatentable over Aravamudan in view of McDowell et al. (U.S. Publication 2002/0035605) (hereinafter “McDowell”) and Horvitz ‘160, and claim 12 as being unpatentable over Aravamudan in view of McDowell. Applicant traverses these rejections for at least the reasons given above with respect to the independent claims. Applicant further notes that the various additional cited references do not overcome the deficiencies of Aravamudan or Horvitz noted above with respect to the independent claims.

The rejections of various ones of the dependent claims are further unsupported by the cited references. However, as the rejections of the independent claims have been



shown to be unsupported, further discussion of the dependent claims is unnecessary at this time.

## CONCLUSION

Applicant submits the application is in condition for allowance, and notice to that effect is requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-69700/RCK.

Respectfully submitted,

/Robert C. Kowert/  
Robert C. Kowert, Reg. #39,255  
Attorney for Applicant(s)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8850

Date: October 15, 2007